

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Michael S. KINCH et al.)
 Patent No.: 7,192,698 B1)
 Issued: March 20, 2007)
 For: EPHA2 AS A DIAGNOSTIC TARGET FOR METASTATIC CANCER)

**PETITION UNDER 37 C.F.R. § 1.181 REQUESTING
CORRECTION OF PATENT TERM ADJUSTMENT**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 C.F.R. § 1.181 Applicants hereby submit a Petition
Requesting Correction of Patent Term Adjustment.

The above-identified patent issued from U.S. Patent Application Serial No. 09/640,952. The Issue Notification in that patent application and the face page of the above-identified patent state that the patent term adjustment is 976 days. Applicants are of the view that this patent term adjustment is incorrect and respectfully request review thereof. For reasons set forth below, Applicants maintain that the patent term adjustment is 943 days.

The following remarks include a brief recitation of relevant file history, a justification for the patent term adjustment correction, and a request.

Relevant File History

On March 20, 2007, the above-identified patent issued.

On October 3, 2007, Applicants submitted a Request for Certificate of Correction that requested correction of, *inter alia*, the patent term adjustment stated the face page of the above-identified patent from 976 days to 943 days. Applicants submit that the request was proper under M.P.E.P. § 2733: "[I]f a notice of allowance indicates a patent term adjustment that is longer than expected, . . . the practitioner (or applicant) may wait until the patent issues, and if the patent issues with a value that is incorrect, request a certificate of correction."

On March 3, 2009, the USPTO mailed a decision on Applicants' Request for Certificate of Correction that denied the request to correct patent term adjustment and approved all other requested corrections. This communication, enclosed herewith as Exhibit A, cites the Examiner's lack of authority to change the Patent Term as reason to deny the request.

Accordingly, Applicants submit herewith a Petition under 37 C.F.R. § 1.181 Requesting Correction of Patent Term Adjustment.

Justification for Correction of Patent Term Adjustment

37 C.F.R. § 1.704(b) states, "[T]he period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed."

A Notice of Missing Parts was mailed on October 10, 2000 (Exhibit B). The Office's calculated patent term adjustment of 976 days failed to take into account the dates associated with the Applicants' response to Notice of Missing Parts, filed on February 12, 2001 (Exhibit C). The date three months after the date of mailing of the Notice of Missing Parts was January 10, 2001. The number of days beginning on the next day (January 11, 2001) and ending on the date Applicants' reply was filed (February 12, 2001) was 33 days. Enclosed herewith, as Exhibit D, is a copy of the Patent Term Adjustment History (3 pages) with the above-referenced transactions identified on page 3. Please note that this history indicates that the 33 days were not taken into account.

The USPTO calculated no patent term adjustment or reduction thereof regarding the above-referenced communications. However, Applicants believe that a reduction of patent term adjustment of 33 days is required. Thus, Applicants believe that the patent term adjustment for the above-identified patent should be 943 days, instead of 976 days.

Letter of Good Faith and Candor Regarding Patent Term Adjustment

Page 3 of 3

Applicant(s): Michael S. KINCH et al.

Patent No.: 7,192,698 B1

Issued: March 20, 2007

For: EPHA2 AS A DIAGNOSTIC TARGET FOR METASTATIC CANCER

Request

Accordingly, Applicants respectfully request a review of the patent term adjustment determination and a response to this Petition under 37 C.F.R. § 1.181 Requesting Correction of Patent Term Adjustment. Further, Applicants respectfully request that the Office of Petitions either (a) reverse the decision of the Decisions & Certificates of Corrections Branch or (b) *sua sponte* issue a supplemental Certificate of Correction to correct the amount of patent term adjustment on the face of U.S. Patent No. 7,192,698 B1 to show 943 days and provide Applicants with a 30-day period to review the Certificate of Correction. Please send any correspondence in response to this Petition under 37 C.F.R. § 1.181 Requesting Correction of Patent Term Adjustment to the undersigned attorney.

Please charge PTO Deposit Account No. 13-4895 in the amount of \$400 to cover the required petition fee. Please charge any additional fees or credit any over-payment to PTO Deposit Account No. 13-4895.

CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper is being transmitted via the U.S. Patent and Trademark Office electronic filing system in accordance with 37 CFR §1.6(a)(4) to the Patent and Trademark Office addressed to: **Mail Stop Petition**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 27th day of April, 2009.

By: 

Name: Margaret S. Willis

April 27, 2009
Date

Respectfully submitted

By

Mueting, Raasch & Gebhardt, P.A.

P.O. Box 581336

Minneapolis, MN 55458-1336

Phone: (612) 305-1220

Facsimile: (612) 305-1228

Customer Number 26813

By: 

Victoria A. Sandberg

Reg. No. 41,287

Direct Dial (612) 305-1226



EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Date Mailed : March 3, 2009

Patent No. : 7,192,698
Patent Issued : March 20, 2007
Docket No. : 3220-66872

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 .

The alleged error(s) not accepted for changes to page 1. Examiners don't have authority to change Patent Term, need to Petition under 37 CFR 1.181. the patent is printed in accordance with the record .In view of the foregoing, your request, in this matter(s), is hereby denied.

A certificate of correction will be issued to correct the remaining error(s) noted in your request.

Further consideration/reconsideration will be given upon receipt of a Request for Reconsideration under, under the provision of U.S.C. 254 or 255 (C.F.R. 1.322 or 1.323), accompanied by the appropriate response or fee of \$100, which should be directed to Decisions & Certificates of Correction Branch.

Ennis Young
Legal Instrument Examiner
(703) 308-9390 ext.117

For Mary Diggs, Supervisor
Decisions & Certificates of Correction Branch
(703) 308-9390 ext. 125 or (703) 303-8309 (Receptionist)

RECEIVED

MAR 09 2009

MUETING AND RAASCH

EXHIBIT B



UNITED STATES PATENT AND TRADEMARK OFFICE

290.00090101

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/640,952	08/17/2000	Michael S. Kinch	3220-66872

Barnes & Thornburg
11 South Meridian Street
Indianapolis, IN 46204

FORMALITIES LETTER



OC000000005462659

Msg Pts 12/10/00 D✓
Stat 4/10/01 Date Mailed: 10/10/2000

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

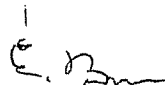
FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given TWO MONTHS from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The oath or declaration is unsigned.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.
- The balance due by applicant is \$ 130.

A copy of this notice MUST be returned with the reply.


Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY

RECEIVED

NOV 02 2000

MUETING AND RAASCH

Receipt is hereby acknowledged for the following in the U.S. Patent and Trademark Office:

Applicant(s): Michael S. KINCH et al.

Serial No.: 09/640,952

Filed: 17 August 2000

Title: EPHA2 AS A DIAGNOSTIC TARGET FOR METASTATIC CANCER (As Amended)

Enclosed: A Petition for Extension of Time for 2 month(s) (1 pg.); Communication Re: Missing Parts (1 pg.); Notice to File Missing Parts of Nonprovisional Application Filed Under 37 C.F.R. 1.53(b) (1 pg.); Declaration and Power of Attorney (12 pgs.); a check in the amount of \$390.00 for the extension fee; a check in the amount of \$130.00, for Missing Parts Surcharge; and transmittal document (in triplicate).

Mailed: February 12, 2001 - Express Mail No.: EL 776902503 US

Docket: 290.0009 0101

VAS/kah

EL 776902503US

Title: EPHA2 AS A DIAGNOSTIC TARGET FOR METASTATIC CANCER
Applicant(s): KINCH et al.
Patent No.: 7,192,698 B1
Issued: March 20, 2007

Docket No. 290.00090101

EXHIBIT C



UNITED STATES POSTAL SERVICE®

POST OFFICE
TO ADDRESSEE



EL 776902503 US

SEE REVERSE SIDE FOR
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ON INSURANCE COVERAGE

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Date In 2/12/01	Postage \$ 12.25
Time In 4:41 PM	Return Receipt Fee
Weight lbs. ozs.	COD Fee Insurance Fee
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Total Postage & Fees \$ 12.25	

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FROM: (PLEASE PRINT) PHONE ()

MUETING & RAASCH
PO BOX 581415
MINNEAPOLIS

MN 55458-1415

TO: (PLEASE PRINT) PHONE ()

Assistant Commissioner for Patents
Attn: Box Missing Parts
Washington, D.C. 20231

L 290.0009 0101

VAS/kah

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www.usps.com



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F02

217

PATENT

Docket No. 290.0009 0101

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Michael S. Kinch et al.)	Group Art Unit:	1645
)		
Serial No.:	09/640,952)	Examiner:	Unknown
)		
Filed:	August 17, 2000)		
)		
For:	EPHA2 AS A DIAGNOSTIC TARGET FOR METASTATIC CANCER			
	(As Amended)			

COMMUNICATION RE: MISSING PARTS

Assistant Commissioner for Patents
Attn: Box Missing Parts
Washington, D.C. 20231

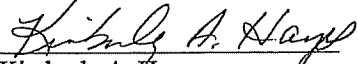
Sir:

In response to the "Notice to File Missing Parts of Application," enclosed is an executed Declaration by the named inventors. Enclosed is our check in the amount of \$130 for the missing parts surcharge. Please charge any additional fees or credit any over-payment to PTO Deposit Account No. 13-4895.

The application should now be in condition for examination. Please direct any inquiries to the undersigned attorney.

CERTIFICATE UNDER 37 C.F.R. 1.10:

Pursuant to 37 C.F.R. 1.10, I verify that this application is being deposited on this 12th day of February, 2001 with the United States Postal Service "Express Mail Post Office to Addressee" service addressed to: Assistant Commissioner for Patents, Attn: Box Missing Parts, Washington, D.C. 20231. "Express Mail" number: EL 776902503 US.

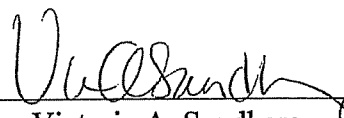

Kimberly A. Hayes

Date

12 February 2001

Respectfully submitted,
Michael S. Kinch et al.
By their Representatives,
Mueting, Raasch & Gebhardt, P.A.
P.O. Box 581415
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Telephone (612)305-1220
Facsimile (612)305-1228
Customer Number 26813

By:



Victoria A. Sandberg

Reg. No. 41,287

Direct Dial (612)305-1226

EXHIBIT D

09/640,952	EPHA2 AS A DIAGNOSTIC TARGET FOR METASTATIC CANCER	03-03-2009::21:59:51
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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 09/640,952

Filing or 371(c) Date:	08-17-2000	USPTO Delay (PTO) Delay (days):	1311
Issue Date of Patent:	03-20-2007	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	335
Post-Issue Petitions (days):	+0	Total PTA (days):	976
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
02-28-2007	PTA 36 Months	1279	
03-20-2007	Patent Issue Date Used in PTA Calculation		
02-09-2007	Dispatch to FDC	↑	
02-09-2007	Application Is Considered Ready for Issue	↑	
02-05-2007	Issue Fee Payment Verified		2
02-05-2007	Issue Fee Payment Received		↑
12-15-2006	Mail Miscellaneous Communication to Applicant		↑
12-11-2006	Miscellaneous Communication to Applicant - No Action Count		↑
11-28-2006	Pubs Case Remand to TC		↑
11-03-2006	Mail Notice of Allowance		↑
10-27-2006	Notice of Allowance Data Verification Completed		
10-27-2006	Case Docketed to Examiner in GAU		
10-17-2006	Date Forwarded to Examiner		
10-09-2006	Amendment after Final Rejection		
08-09-2006	Mail Final Rejection (PTOL - 326)		
08-07-2006	Final Rejection		
09-21-2004	Information Disclosure Statement considered		
06-02-2006	IFW TSS Processing by Tech Center Complete		
05-23-2006	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		
06-02-2006	Date Forwarded to Examiner		
05-23-2006	Response after Non-Final Action		61
05-23-2006	Request for Extension of Time - Granted		↑
09-21-2004	Information Disclosure Statement (IDS) Filed		↑
12-16-2005	Miscellaneous Incoming Letter		↑
12-23-2005	Mail Non-Final Rejection	8	
12-19-2005	Non-Final Rejection	↑	
08-18-2005	Date Forwarded to Examiner	↑	
08-15-2005	Amendment after Final Rejection	↑	
06-28-2005	Case Docketed to Examiner in GAU		
06-17-2005	Mail Final Rejection (PTOL - 326)		

06-13-2005	Final Rejection		
03-15-2005	Information Disclosure Statement (IDS) Filed		
03-29-2005	Date Forwarded to Examiner		
03-15-2005	Response after Non-Final Action		
12-15-2004	Mail Non-Final Rejection		
12-13-2004	Non-Final Rejection		
09-21-2004	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		
09-21-2004	Reference capture on IDS		
09-21-2004	Information Disclosure Statement (IDS) Filed		
09-28-2004	Date Forwarded to Examiner		
09-21-2004	Response after Non-Final Action		62
09-21-2004	Request for Extension of Time - Granted		↑
09-21-2004	Workflow incoming amendment IFW		↑
04-21-2004	Mail Non-Final Rejection	2	
04-20-2004	Non-Final Rejection	↑	
02-17-2004	IFW Amended case processing Complete	↑	
12-19-2003	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received	↑	
02-17-2004	Date Forwarded to Examiner	↑	
12-19-2003	Response after Non-Final Action		91
12-19-2003	Request for Extension of Time - Granted		↑
02-17-2004	IFW Amended case processing Complete		↑
11-24-2003	Preliminary Amendment		↑
06-19-2003	Mail Non-Final Rejection		↑
06-16-2003	Non-Final Rejection		
03-24-2003	Information Disclosure Statement (IDS) Filed		
03-24-2003	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		
04-08-2003	Date Forwarded to Examiner		
03-24-2003	Response after Non-Final Action		61
03-24-2003	Request for Extension of Time - Granted		↑
10-22-2002	Mail Non-Final Rejection	22	
10-21-2002	Non-Final Rejection	↑	
10-17-2002	Case Docketed to Examiner in GAU	↑	
05-30-2002	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received	↑	
05-30-2002	Information Disclosure Statement (IDS) Filed	↑	
08-13-2002	Date Forwarded to Examiner	↑	
05-30-2002	Response after Non-Final Action		58
05-30-2002	Request for Extension of Time - Granted		↑
02-26-2002	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received		↑
01-22-2002	Information Disclosure Statement (IDS) Filed		↑
01-02-2002	Mail Non-Final Rejection		↑
12-31-2001	Non-Final Rejection		

10-20-2001	Date Forwarded to Examiner
10-05-2001	Response after Non-Final Action
10-05-2001	Information Disclosure Statement (IDS) Filed
10-05-2001	Conversion under Rule 45
07-05-2001	Mail Non-Final Rejection
07-02-2001	Non-Final Rejection
→ 02-12-2001	Preliminary Amendment
02-12-2001	Information Disclosure Statement (IDS) Filed
03-16-2001	Information Disclosure Statement (IDS) Filed
03-12-2001	Case Docketed to Examiner in GAU
03-01-2001	Application Dispatched from OIPE
02-28-2001	Application Is Now Complete
→ 10-10-2000	Notice Mailed--Application Incomplete--Filing Date Assigned
10-10-2000	Correspondence Address Change
09-08-2000	IFW Scan & PACR Auto Security Review
08-17-2000	Initial Exam Team nn

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